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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,152	05/24/2000	Stefano Faccin	017.38448X00	4942

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EXAMINER

LEE, JOHN J

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 01/16/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/577,152

Applicant(s)

FACCIN ET AL.

Examiner

JOHN J LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. **Claims 1 – 11 and 13- 30** are rejected under 35 U.S.C. 102(e) as being anticipated by Timonse et al. (US 2002/0058494).

Regarding **claims 1 and 25**, Timonse discloses that a method for coordinating charging information in a communications network (Fig. 1 and pages 3, paragraphs 30 – 32). Timonse teaches that establishing a communication channel (Fig. 1 and pages 3, paragraphs 28 – 29 where teaches mobile user is establishing a connection with mobile communication network). Timonse teaches that associating a charging identification with said communication channel (Fig. 1 and pages 2, paragraphs 18 – pages 3, paragraphs 22). Timonse also teaches that sending said charging identification from a first network

element in the transport layer (mobile station or GPRS support node or could be anything in Fig. 1) to a second network element in the application layer (visit network or could be anything in Fig. 1) (Fig. 1, pages 5, paragraphs 50 – pages 6, paragraphs 53, and pages 8, paragraphs 77 - 78 where teaches third party, mobile station, or credit company in GSM mobile communication network (GPRS Node) transmits to charging ID information to visit network).

Regarding **claim 2**, Timonse discloses that the second network element adds said charging identification to charging identification, which said second network element collects (pages 2, paragraphs 18, Fig. 1, and pages 9, paragraphs 80).

Regarding **claim 3**, Timonse discloses that the first network element sends an address of a network element together with said charging identification to said second network element (pages 2, paragraphs 18, Fig. 1, and pages 9, paragraphs 80).

Regarding **claim 4**, Timonse discloses that the second network element adds said address of a network element to charging information which said second network element collects (pages 2, paragraphs 18, Fig. 1, and pages 9, paragraphs 80).

Regarding **claim 5**, Timonse discloses that the first network element sends security information together with said charging identification to said second network element (pages 1, paragraphs 3 – 4, Fig. 1, and pages 2, paragraphs 18).

Regarding **claim 6**, Timonse discloses that the second network element verifies said charging identification against said security information (pages 5, paragraphs 43, Fig. 1, and pages 5, paragraphs 50 – pages 6, paragraphs 53).

Regarding **claims 7 and 26**, Timonse discloses that the communication channel is Packet Data Protocol (PDP) context (Fig. 1 and pages 5, paragraphs 50 – pages 6, paragraphs 53).

Regarding **claims 8 and 27**, Timonse discloses that the charging identification is a GGSN allocated Charging ID (Fig. 1 and pages 8, paragraphs 78 – pages 9, paragraphs 80).

Regarding **claims 9 and 28**, Timonse discloses that the first network element is Mobile Station (MS) (Fig. 1 and pages 3, paragraphs 28 – 29).

Regarding **claims 10 and 29**, Timonse discloses that the first network element is Serving GPRS Support Node (SGSN) (Fig. 1 and pages 8, paragraphs 78 – pages 9, paragraphs 80).

Regarding **claims 11 and 30**, Timonse discloses that the first network element is a Gateway GPRS Support Node (GGSN) (Fig. 1 and pages 8, paragraphs 78 – pages 9, paragraphs 80).

Regarding **claim 13**, Timonse discloses that an SGSN sends the address of a network element to said first network element (Fig. 1 and pages 8, paragraphs 78 – pages 9, paragraphs 80).

Regarding **claim 14**, Timonse discloses that the address of a network element is an address of a GGSN (Fig. 1 and pages 8, paragraphs 78 – pages 9, paragraphs 80).

Regarding **claim 15**, Timonse discloses that the transport layer is a GPRS/UMTS (Fig. 1 and pages 8, paragraphs 78 – pages 9, paragraphs 80).

Regarding **claim 16**, Timonse discloses that the transport layer is Packet Switched Core Network domain (Fig. 1 and pages 8, paragraphs 78 – pages 9, paragraphs 80).

Regarding **claim 17**, Timonse discloses that the application layer is a IP Multimedia Core Network domain (Fig. 1 and pages 8, paragraphs 78 – pages 9, paragraphs 80).

Regarding **claim 18**, Timonse discloses that the communication network is a packet switched wireless network (Fig. 1 and pages 8, paragraphs 78 – pages 9, paragraphs 80).

Regarding **claim 19**, Timonse discloses that sending said charging identification is performed autonomously (Fig. 1, pages 5, paragraphs 50 – pages 6, paragraphs 53, and pages 8, paragraphs 77 – 78).

Regarding **claim 20**, Timonse discloses that sending said charging identification is performed based on a request from said second network element (pages 5, paragraphs 50 – pages 6, paragraphs 52 and Fig. 3).

Regarding **claim 21**, Timonse discloses that the second network element sends said charging identification towards an endpoint of a communication (pages 5, paragraphs 50 – pages 6, paragraphs 52 and Fig. 3).

Regarding **claim 22**, Timonse discloses that the second network element sends security information together with said charging identification toward said endpoint of a communication (pages 1, paragraphs 3 – 4, Fig. 1, and pages 5, paragraphs 50 – pages 6, paragraphs 52).

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Regarding **claim 23**, Timonse discloses that the second network element sends an address of a network element together with said charging identification to said endpoint of a communication (Fig. 1 and pages 5, paragraphs 50).

Regarding **claim 24**, Timonse discloses all the limitation, as discussed in claims 1 and 4.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 12 and 31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Timonse in view of Widegren et al. (US Patent number 6,621,793).

Regarding **claim 12**, Timonse does not specifically disclose the limitation “the second network element is a Call State Control Function (CSCF)”. However, Widegren discloses the limitation “the second network element is a Call State Control Function (CSCF)” (column 19, lines 12 – 32 and Fig. 20). It would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the Timonse system as taught by Widegren. The motivation does so would be to improve controlling calling state for efficient charging in mobile packet data communication system.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Donovan et al. (US Patent number 6,453,158) discloses Wireless Prepaid Platform Integration with Standard Signaling.

Sayers et al. (US 2003/0186694) discloses Integrated Wireless Communications In Private and Public Network Environments.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-6606 (for informal or draft communications, please label
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John J. Lee** whose telephone number is **(703) 306-5936**. He can normally be reached Monday-Thursday and alternate Fridays from 8:30am-5:00 pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, **Nay Aung Maung**, can be reached on **(703) 308-7745**. Any inquiry of a general nature or

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relating to the status of this application should be directed to the Group receptionist
whose telephone number is (703) 305-4700.

J.L

January 9, 2004

John J Lee

A handwritten signature in black ink, appearing to read "John J Lee", with a long horizontal flourish extending to the right.